

Application No.: 10/690,050
Reply to Notice of Non-Compliant Amendment of August 29, 2006

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Remarks/Arguments

This Reply is in response to the Notice mailed on August 29, 2006. Claim 1 has been amended as per the Examiner's suggestion. Claims 2, 4, 5 and 8 have been canceled. Support for the amended claim 3 can be found from elements listed in tables 1-41. Support for new claims 10 and 11 can be found from the figures and tables in the application and on page 34, lines 2 and 3. Support for claim 12 can be found on pages 16-18, for example. Support for claim 13 can be found on page 13, line 27 to page 14, line 7. A confirmation on the unique characteristic of the manufactured copper ingot from third party companies can be found in the Declaration filed under 37 CFR 1.132, which was submitted in the June 2, 2006 amendment. The errors in the specification have been corrected by the amendment set forth above.

No new matter is added by virtue of these amendments.

Obviousness Type Double Patenting

All claims have been rejected under the doctrine of obviousness-type double patenting over US patent No. 6,572,792 and 6,921,497. A terminal disclaimer was filed on May 30, 2006. Withdrawal of the rejection is respectfully requested. It is further noted that the presentation of claims from the copending applications will likely raise double patenting issues, in particular USSN 10/659,090. Terminal disclaimers will be filed as appropriate upon the allowance of any overlapping or obvious claim in a copending application.

Rejection Under 35 U.S.C. §101

The Examiner rejected claims 1-9 in each of the copending applications, stating that the disclosed invention is inoperative and therefore lacks utility, asserting that "the instant compositions cannot exist according to conventional scientific theory." Applicant respectfully disagrees. While not bound by the theory, the Applicant has provided substantial data and evidence that supports the conclusion that the claimed compositions are characterized by a modification to the composition's electronic state. This data has

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been confirmed by third parties. As established by the evidence presented in the specification with respect to the physical properties (altered magnetism, ductility, resistivity, reactivity, etc.) that flow from altering an element's electronic state enables the new composition of matter for a variety of utilities. Applicant respectfully requests that the rejection under 35 U.S.C. §101 be withdrawn.

Rejection Under 35 U.S.C. §112, First Paragraph

The Examiner rejected claims 1-9 stating that the specification does not describe the invention or enable one of ordinary skill in the art to make or use a composition of matter that is distinguishable from its naturally occurring state, in that it would require undue experimentation to do so.

The Applicant respectfully traverses. Applicant has presented 14 working examples with detailed XRF analysis that showed each of the manufactured ingots contains a different elemental signature from its corresponding natural occurring metal state. There is no basis to conclude that the result is explained by impurities introduced into the process and/or undetected in the starting materials or from transmutation of metals. The manufactured ingots are still the same starting metal, but exhibit different electronic state scans from their original precursor in the GMS, XRF, PIXE, and GDOES analyses. Confirmation of these analyses from third party companies has been submitted. No more is required under the law.

It is noted that these rejections have been withdrawn in USSN 10/659,090 for the narrower scope of claim. It is believed that the rejection based upon the description requirement has clearly been overcome as well for these claims for the same reasons. With respect to the rejection based on the enablement requirement, the issue is believed to be whether the specification enables the person of skill in the art to make a claimed composition containing an element other than a transition metal or silicon. Based upon the breadth of the exemplification provided to date, it is believed that Applicant has satisfied his burden for the full scope of the claims.

Withdrawal of the rejection is respectfully requested.

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Rejection Under 35 U.S.C. §112, Second Paragraph


The Examiner further rejected claims 1-3 stating that the claimed "Uniquant analysis report" is a trademark software program and therefore the claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. As per the suggestion of the Examiner, claim 1 has been amended to recite "an X-ray fluorescence" instead of "a calibrated Uniquant". Applicant respectfully requests that the rejection be withdrawn.

Conclusion

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned at (978) 251-3509.

Respectfully submitted,

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